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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,167	11/06/2002	John Granville Kay	7413-3	2751

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,167

Applicant(s)

KAY ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 35-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/02, 2/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 31 - 39 in the reply filed on August 25, 2004 is acknowledged. The traversal is on the ground(s) that the U.S. patent provides *prima facie* evidence that the claims should not be subject to a restriction requirement and that the obvious and anticipated restriction contradicts the issue of patent US 6,579,610. This is not found persuasive because even though the other Examiner did not require the restriction, there is still a valid restriction due to the anticipation of US Patent 5,965,198. The Examiner realizes that US Patent US 6,579,610 was allowed with identical claims; however, it is the Examiners belief that US Patent 5,965,198 still anticipates the invention, as shown by the rejection below, and thereby making the restriction valid.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 31 – 55 have been renumbered 26 – 55.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “in the material” in claim 26 is unclear, which render the claims vague and indefinite. It is unclear from the claims where the aggregate is embedded, the polyvinyl chloride layer or the barrier layer of polymeric material.

The phrase “exposed at the surface of the barrier layer” in claim 26 is unclear, which renders the claim vague and indefinite. It is unclear from the claims which surface of the barrier layer the aggregate is exposed, the inner or outer surface.

Clarification/correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 26 – 29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Sachs et al. (USPN 4,196,243).

Sachs et al. disclose a non-skid floor covering with a wear, barrier, layer fused over a polyvinyl chloride substrate (Column 1, lines 60 – 62 and 66). Since the two layers of materials are fused together, it is inherent that the barrier layer is at least as flexible as the underlying polyvinyl chloride layer. The wear layer is made with a thermoplastic material of a polyurethane material (Column 2, lines 36 – 37), which is cured through exposure to an ultra-violet light (Column 5, line 29). Incorporated in with the wear layer are non-skid plastic particles, aggregate, exposed to a surface to provide surface roughness (Column 7, lines 29 – 40).

7. Claims 26 – 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (USPN 5,433,979).

Williams discloses a non-slip surface (Column 3, lines 1 – 2) comprising a polyvinyl chloride floor matting material (Column 3, lines 10 – 11) covered with a barrier material of polyurethane or polyester, which is used to provide a surface roughness on an exposed surface through an aggregate material of silicon carbide embedded in the surface (Column 4, 11 – 36). The barrier layer is a cured thermoplastic material (Column 4, lines 39 – 46) that is flexible as the underlying polyvinyl chloride layer (Column 3, lines 61 – 68) and is transparent (Column 5,

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lines 27 – 34). The barrier layer provides enhanced dirt release and stain resistance in comparison with the polyvinyl chloride layer (Column 2, lines 37 – 40) while being shaped, embossed, through deformation (Column 3, lines 22 – 25).

8. Claims 26, 28, 29 and 33 rejected under 35 U.S.C. 102(e) as being anticipated by Plusquellec et al. (USPN 5,965,198).

Plusquellec et al. disclose a non-skid floor covering with a coating, barrier, layer fused over a polyvinyl chloride substrate (Column 4, lines 14 – 20). Since the two layers of materials are fused together, it is inherent that the barrier layer is at least as flexible as the underlying polyvinyl chloride layer. The coating layer is made with a thermoplastic material (Column 12, lines 33 – 36) where incorporated in with the coating layer are vinyl polymer plastic particles, aggregate, exposed to a surface to provide surface roughness (Column 6, lines 29 – 31).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer

Examiner

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HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/28/04